

2. PCT Administrative Instructions Annex B, paragraph (f) further provides that for Markush practice where a single claim defines alternatives, the requirement for technical relationship and special technical features is met when the alternatives are of a similar nature.

3. Alternatives of chemical compounds are of a similar nature where (A) all alternatives have a common property or activity, and (B) a common structure is present, i.e., a significant structural element is shared by all of the alternatives.

4. The phrase “significant structural element is shared by all of the alternatives” refers to cases where “the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.”

Taken together the above points 1-4 indicate that the requirement for unity of invention in Markush practice is satisfied when:

- i) all alternatives have a common property or activity; and
- ii) (a) the compounds share a common chemical structure which occupies a large portion of their structures; or (b) in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity.

In the instant case the claimed compounds all share a common chemical structure, i.e., α -hydroxycarboxamide that is N-substituted with phenyl-substituted 6-membered arylmethyl. This common chemical structure of the claimed compounds occupies a large portion of their structures, and is therefore a significant structural element shared by all the alternatives. Since all compounds have a common activity - as antagonists at the bradykinin B1 receptor, the requirement for unity of invention, without more, is satisfied.

It is therefore not necessary for the unity of invention analysis to consider the Examiner's contention that the claimed compounds lack a special technical feature that defines a contribution over the prior art. However, even if it were, the Examiner's failure to cite any art in support of the position taken renders that position untenable. In view of the above amendment and remarks Applicants respectfully request that the Examiner reconsider, and withdraw the

restriction requirement among Groups I, III and V and examine the compound claims in whole as presented.

Election of Species

In response to the requirement to elect a species, Applicants hereby elect the species of Example 2. Claims readable thereon are 1, 4, 5, 9, 10, 11, 12 and 13.

Respectfully submitted,

By /Mollie M. Yang, Reg. # 32718/
Mollie M. Yang
Reg. No. 32,718
Attorney for Applicants
Merck & Co., Inc.
P.O. Box 2000
Rahway, NJ 07065-0900
(732) 594-6343

Date: October 2, 2009